

FACSIMILE TRANSMITTAL SHEET

TO	Jonathan O. Owens	FROM	Wanda L. Walker, SPE AU 1722/23
MY FIRM	Havenstock & Owens, LLP	DATE	9 15 03
FAX NUMBER	408 530 9797	TOTAL NO. PAGES (WITH ATTACHMENTS)	2
PHONE NUMBER	408 530 9700	DATE AND REFERENCE NUMBER	09 579938
RE	Review of 102(b) multiple references	YOUR REFERENCE NUMBER	TJW 00100

☒ Per your request ☐ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY ☐ PLEASE RECYCLE

NOTES/COMMENTS

Mr. Owens

Per your request, I have reviewed the finality of serial number 09 579938 and find the action proper. From your earlier fax directed to me, it is my understanding that the multiple 102(b) rejections containing art directed to beverage containers rather than to the claimed paint containers is the main issue.

In re Schreiber, 44 USPQ2d 1429 (1997), poses the issue "...whether reference is analogous art is irrelevant to whether that reference anticipates claimed invention; reference may be from entirely different field of endeavor from that of claimed invention or may be directed to entirely different problem from that addressed by inventor, yet reference will still anticipate if it explicitly or inherently discloses every limitation recited in claims."

Schreiber states "There is no dispute that the structural limitations recited in Schreiber's application are all found in the Harz reference upon which the examiner and the Board relied. Thus, to use the terms found in Schreiber's claim 1, Harz discloses a "dispensing top" that has a "generally conical shape and an opening at each end," and "means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform." Schreiber argues, however, that Harz does not disclose that such structure **to dispense popcorn** (my emphasis), the absence of a disclosure relating to function does not defeat the Board's finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable."

In the instant application, the Examiner Sorkin has gone to great lengths to compare every item of the claim to each reference. So much so, I believe that there is no dispute that the structural limitations recited are shown in each of the references of concern.

Thank you,
Wanda L. Walker
 US Patent and Trademark Office
 Supervisory Patent Examiner
 AU 1722/23

 *** TX REPORT ***

TRANSMISSION OK

TX/RX NO 2314
 CONNECTION TEL 914085309797
 SUBADDRESS
 CONNECTION ID HAVERSTOCK&OWENS
 ST. TIME 09/15 10:49
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 PGS. 1
 RESULT OK

IN RE 09/579938

FACSIMILE TRANSMITTAL SHEET

TO: Jonathan C. Owens	FROM: Wanda L. Walker, SPE AU 1722/23
COMPANY: Haverstock & Owens, LLP	DATE: 9/15/03
FAX NUMBER: 408-530-9117	TOTAL NO. OF PAGES INCLUDING COVER: 2
PHONE NUMBER: 408-530-9110	SENDER'S REFERENCE NUMBER: 09/579938
RE: Review of 102(b) multiple references	YOUR REFERENCE NUMBER: TJW-00100

☒ Per your request ☐ FOR REVIEW ☐ PLEASE COMMENT

☐ PLEASE REPLY

☐ PLEASE RECYCLE

NOTES/COMMENTS:

Mr. Owens:

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In re Schreiber, 41 USPQ2d 1429 (1997), poses the issue "...whether reference is analogous art is irrelevant to whether that reference anticipates claim invention, reference may be from entirely different field of endeavor from that of claimed invention or may be directed to entirely different problem from that addressed by inventor, yet reference will still anticipate if it explicitly or inherently discloses every limitation recited in claims."

Schreiber states "there is no dispute that the structural limitations recited in Schreiber's application are all found in the Harz reference upon which the Examiner and the Board relied. Thus, to use the terms found in Schreiber's claim 1, Harz discloses a "dispensing top" that has a "generally conical shape and an opening at each end," and "means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform." Schreiber argues, however, that Harz does not disclose that such structure to dispense popcorn (my emphasis), the absence of a disclosure relating to function does not defeat the Board's finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable."

In the instant application, the Examiner Sorokin has gone to great lengths to compare every item of the claim to each reference. So much so, I believe that there is no dispute that the structural limitations recited are shown in each of the references of concern.